

REMARKS

I. INTRODUCTION

The Non-Final Office Action mailed October 1, 2009 (hereinafter “the Office Action”), has been carefully considered. In light of the following discussion, favorable reconsideration of the present application is respectfully requested.

II. STATUS OF THE CLAIMS

Claims 34, 36, 37, 39-45, 47-58, 60-70, and 72-75 are pending, with Claims 34 and 70 being independent. By the present Amendment, Claims 34, 36, 37, 39-45, 47-58, 60-70, and 72-75 are amended; and Claims 35, 38, 46, 58, 59, and 71 are cancelled without prejudice or disclaimer of the subject matter recited therein. For the reasons discussed in more detail below, Applicant respectfully submits that no new matter is added by those amendments.

Independent Claim 34 is amended to recite the features previously recited in dependent Claim 35, and independent Claim 70 is amended to recite the features previously recited in dependent Claim 71 – namely, an input means that includes a disassembling means adapted to record information about and disassemble the object. Independent Claims 34 and 70 are also each amended to recite that “the at least one element contain[s] information about the object.” Support for those amendments is provided, for example, at page 7, lines 18-21 of the Specification, wherein molecular data (i.e., information) about the object is disclosed as being part of what is transmitted via the transmission means. In addition, independent Claims 34 and 70 are each amended to recite that the input means is at a seller’s location and the output means is at a buyer’s location. Support for those amendments is provided, for example, at page 9, line 27, through page 10, line 1, of the

Specification, wherein the input means and the output means are disclosed as being at different locations.

The amendments to the dependent claims merely address matters of form. For example, dependent Claims 36, 37, 39-45, 47-58, and 60-69 are each amended to recite “The system of Claim X” in lieu of “An assembling as claimed in Claim X”; and dependent Claims 36, 41, 42, 45, and 67 are amended to depend from independent Claim 34 in lieu of dependent Claim 35. Similar amendments are made to the claims that depend from independent Claim 70.

III. SUMMARY OF THE OFFICE ACTION

The Office Action rejects Claims 34-75 under 35 U.S.C. § 101 for lack of utility; rejects Claims 34-75 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement; and rejects Claims 34, 37-40, 43, 44, 47-67, 70, 72, and 73 under 35 U.S.C. § 102(b) as anticipated by PCT Application Publication No. WO 03/019299 to *Philippou* (hereinafter “*Philippou*”). For the reasons discussed below, those rejections are respectfully traversed.

IV. CLAIM REJECTIONS

A. Rejection of Claims 34-75 Under 35 U.S.C. § 101

The Office Action rejects Claims 34-75 under 35 U.S.C. § 101 for lack of utility. In more detail, the Office Action rejects those claims for lack of utility based on the conclusion that the claimed invention is inoperative. In support of that conclusion, the Office Action states:

[T]he applicant is claiming an abstract idea to replicate matter and/or transport matter from one local to another which is just that, an abstract idea which is not entitled to patenting as it does not satisfy the requirements of being one of statutory subject matter.

Office Action at p. 2. Applicant respectfully disagrees.

As set forth in MPEP § 2107.01(II) at 2100-24, “the defense of non-utility cannot be sustained without proof of total incapacity.” (citing *E.I. du Pont De Nemours and Co. v. Berkley and Co.*, 620 F.2d 1247, 1260 n.17 (8th Cir. 1980) (emphasis added). Moreover, as set forth at MPEP § 2107.02(IV) at 2100-31,

To properly reject a claimed invention under 35 U.S.C. 101, the Office must (A) make a *prima facie* showing that the claimed invention lacks utility, and (B) provide a sufficient evidentiary basis for factual assumptions relied upon in establishing the *prima facie* showing.

(citing *In re Gaubert*, 524 F.2d 1222, 1224 (CCPA 1975)) (emphasis added). The Office action has provided no such proof and relies solely on the Examiner’s personal knowledge. See, e.g., Office Action at p. 3 (“Matter cannot be created from energy to the best of my knowledge.”) (emphasis added). Applicants therefore respectfully request reconsideration and withdrawal of the rejection of Claims 34-75 under 35 U.S.C. § 101.

B. Rejection of Claims 34-75 Under 35 U.S.C. § 112, First Paragraph

The Office Action rejects Claims 34-75 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In more detail, the Examiner rejects those claims for not being enabled by the Specification. Relying largely on the assertions made in the rejection under 35 U.S.C. § 101, the Office Action states:

[T]he assembly system proposed by applicant simply is not capable of functioning in the manner described. One cannot make an object of matter from subatomic or atomic particles and/or impulses of energy which are inputted and transmitted from one local to another to make matter.

Office Action at p. 3. Those statements, however, are pertinent primarily with respect to the rejection under 35 U.S.C. § 101 and are, therefore, addressed above with respect to that rejection.

The Office Action also states that “the manner of transmitting and inputting the atomic and subatomic particles is not described in any meaningfully manner to make it so that one can make and/or use the invention in the manner described.” Office Action at p. 3. As set forth in MPEP § 2163.07(a) at 2100-192, “[b]y disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it.” A person having ordinary skill in the art would readily appreciate that the devices described in the Specification inherently operate according to well-known theories (e.g., Einstein’s theories on quantum physics, such as quantum entanglement). Accordingly, the Specification necessarily discloses those theories and enables the features alleged by the Office Action to not be described in any meaningful manner. Applicant, therefore, respectfully requests reconsideration and withdrawal of the rejection of Claims 34-75 under 35 U.S.C. § 112, first paragraph.

C. Rejection of Claims 1, 46, 47, 49, 50, 56, 57, 72, 74, 75, 77, 78, and 84-89 Under 35 U.S.C. § 102(b)

The Office Action rejects Claims 34, 37-40, 43, 44, 47-67, 70, 72, and 73 under 35 U.S.C. § 102(b) as anticipated by *Philippou*. As amended, independent Claims 34 and 70 now recite a “at least one disassembling means ... adapted to record the information about and disassemble the object.” That feature was previously recited in now-cancelled dependent Claims 35 and 71. Nowhere does *Philippou* disclose such a feature, as the Office Action appears to concede by excluding dependent Claims 35 and 71 from the rejection under 35 U.S.C. § 102(b).

Because *Philippou* fails to disclose each and every feature recited in independent Claims 34 and 70 – namely, a disassembling means adapted to record information about an object and disassemble the object – Applicant respectfully submits that *Philippou* does not anticipate those claims. Likewise, by virtue of their dependency on independent Claims 34 and 70, Applicant respectfully submits that corresponding dependent Claims 37-40, 43, 44, 47-67, 72, and 73 also are not anticipated by *Philippou*. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of 34, 37-40, 43, 44, 47-67, 70, 72, and 73 under 35 U.S.C. § 102(b).

V. CONCLUSION

In view of the foregoing discussion, it is respectfully submitted that this application is in condition for allowance. An early and favorable action is therefore respectfully requested.

In the event there are any questions relating to this Amendment or to the application in general, it would be appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that prosecution of this application may further be expedited.

Please charge any shortage of fees or credit any overpayment thereof to BLANK ROME LLP, Deposit Account No. 23-2185 (130451.0103). In the event that a petition for an extension of time is required to be submitted herewith and in the event that a separate petition does not accompany this response, applicant hereby petitions under 37 C.F.R. 1.136(a) for an extension of time for as many months as are required to render this submission timely. Any fees due are authorized above.

*Application No. 10/549,808
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Respectfully submitted,

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